
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rowe et al.	Attorney Docket No.: IGT1P205/P000899-001
Application No.: 10/767,808	Examiner: Jason Paul Pinheiro
Filed: January 29, 2004	Group: 3714
Title: METHOD AND APPARATUS FOR PROVIDING CUSTOMIZED GAMES AND GAME CONTENT FOR A GAMING APPARATUS	Confirmation No.: 5545

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Signed: /Christian D. Scholz/
Christian D. Scholz

PRE-APPEAL REQUEST FOR REVIEW

35 U.S.C. §103(a) Rejection of Claims 1-2, 4-12, 14-26, 28, 30, and 32-38

The Office Action stated that claims 1-2, 4-12, 14-16, 28, 30, and 32-38 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Pat. App. Pub. No. 2002/0142846 to Paulsen (hereinafter “Paulsen”) in view of U.S. Pat. App. Pub. No. 2002/0142825 to Lark et al. (hereinafter “Lark”).

Claim 1 recites a gaming system comprising, among other elements, a “network server controller ... programmed to ... receive preference data relating to preferences of a plurality of players including a first player and a second player, receive game characteristics data relating to game characteristics of a plurality of available games, select a game from said plurality of available games by comparing said preferences of said first player with said preferences of said second player, [and] provide said game in response to said request ...”

The Examiner, in the present Office Action and in the previous three Office Actions (dated January 5, 2010; May 12, 2009; and August 22, 2008), has maintained that Lark teaches “selecting an available game by comparing said first player preferences with said preferences of said second player (paragraph [0124]).” (June 15, 2010, Office Action, page 3, lines 15-17).

Applicants have, in response to each of these Office Actions, contested the Examiner’s interpretation of Lark.

In response, the Examiner has stated, for example, that “... Lark discloses selecting an available game by comparing said first player preferences with said preferences of said second

device to provide gaming in accord with the second player's preferences, the gaming device must compare the second player's preferences with the first player's preferences to determine if the gaming device preferences must be modified.

In order for the Examiner's argument to be valid, however, two preconditions must necessarily be met. The first is that the hypothetical gaming device must retain the first player preferences as the current preferences after the first player finishes playing on the gaming device using the first player preferences. The second is that the hypothetical gaming device must be configured such that the only way that second player preferences may be implemented is to first compare them against the first player preferences currently in active use by the gaming device to determine if those first player preferences must be modified.

The first precondition is required because if the hypothetical gaming device does not retain the first player preferences after the first player finishes playing, then the hypothetical gaming device will not have access to the first player preferences at the same time as the gaming device has access to the second player preferences. The hypothetical gaming device would not, therefore, be able to compare them. Furthermore, the first player preferences must be retained as the current preferences of the gaming device; otherwise, there would be no need to modify them as postulated by the Examiner's hypothetical.

The second precondition is required because if the hypothetical gaming device implements the second player preferences without regard for the first player preferences at all, then there is no need to compare the first player preferences and the second player preferences.

Neither precondition is suggested in Lark. Lark does not indicate that first player preferences are actively used by a gaming device after a first player finishes a gaming session—they may be output to a configuration instrument, such as a printed ticket, stored in memory for later retrieval by the first player, or simply erased. The Lark gaming device might continue to behave according to the first player's preferences, as the Examiner has hypothesized. More likely, however, is that a gaming device would simply revert to default settings so that the next player—who may or may not have a preferences account—is not subjected to the particular whims of the first player.

For example, an 87-year old grandmother with poor eyesight sitting down at a gaming device for a nice quiet game of bingo might resent being bombarded with the entertainment preferences of the previous player, who happened to be a 21-year old man with preferences instructing the gaming device to display Ultimate Fighting Championships bouts in a display

area, play rap music through the gaming machine speakers, and use an 8-point font for any button labels. The 21-year old man would no doubt also prefer not to be exposed to the preferences of the 87-year old grandmother if their positions were reversed. Such situations can be avoided if the gaming device reverts to a “casino default” preferences configuration after a player using their own preferences on the gaming device concludes their play session. Since the casino business model relies heavily on providing customers with an enjoyable gaming experience, the use of such casino default preferences appears to be very prudent. Thus, not only is the first precondition not disclosed in Lark, it is not even the most likely hypothetical situation.

Lark also does not indicate a gaming device configured such that a second player's preferences can only be implemented on the gaming device through comparison to a first player's preferences. Applicants note that common sense suggests that when a second player initiates play using second player preferences, the gaming device would simply load the second player preferences into memory without regard for any first player preferences previously stored in the memory. This is computationally more efficient.

For example, under the Examiner's hypothetical, each first player preference must be compared to each corresponding second player preference to determine if the first and second player preferences are different. If so, then the first player preference would need to be replaced by the corresponding second player preference. If not, then the first player preference setting would be left alone. Thus, one operation (i.e., comparing) or two operations (i.e., comparing and replacing) must be performed for each preference in the Examiner's hypothetical. Thus, the number of operations required under the Examiner's hypothesis is between X and $2X$, where X represents the number of preferences involved. By contrast, if the hypothetical gaming device simply replaces all of the first preferences with all of the second preferences without comparing them, the number of operations will simply be X .

A Comment on Inherency

The Examiner appears to be interpreting a reference as disclosing features that are simply not explicitly disclosed by the reference. The only situation in which this is permissible is if such features are *inherently* disclosed in the reference. M.P.E.P. §2112(IV) requires that the Examiner must provide a rationale or evidence tending to show such inherency.

M.P.E.P. §2112(IV) states that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or

characteristic.” M.P.E.P. §2112(IV) also states “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’”

In other words, the mere fact that an Examiner can produce a hypothetical which reads on a claimed invention *and* is compatible with the disclosure of a reference is not sufficient to show that the hypothetical is necessarily taught by that reference. In fact, for the Examiner’s hypothetical to be inherently taught by the reference, it must necessarily flow from the reference. If an alternate hypothetical may flow from the reference, such as discussed above, then the Examiner’s hypothetical *cannot* be said to necessarily flow from the reference.

While M.P.E.P. §2112(IV) discusses the requirements for anticipation under 35 U.S.C. §102, it is still axiomatic that 35 U.S.C. §103(a) references must, in combination, teach all of the recited elements of a claim or render them obvious. A reference which fails to inherently teach a recited claim element in a 35 U.S.C. §102 context does not suddenly overcome this deficiency through the use of a 35 U.S.C. §103(a) rejection—the recited element must still be shown to be taught. In this case, the Examiner has essentially stated that Lark, on its own, inherently teaches the above-discussed features without satisfying the requirements of M.P.E.P. §2112(IV).

Conclusion

Applicants respectfully submit that the rejection of claim 1, as well as the other independent and dependent claims which incorporate elements similar to those discussed above, is clearly in error because the cited references simply do not teach all of the recited elements. Applicants thus respectfully request the withdrawal of the rejections.

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100

/Christian D. Scholz/
Christian D. Scholz
Reg. No. 58,024

/John F. Griffith/
John F. Griffith
Reg. No. 44,137